

REMARKS

The Official Action of May 5, 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The indicated allowability of claims 22-24 and 33-35, if rewritten in independent form to include all of the limitations of the base claim and any intervening claims, has been noted with appreciation. The remaining claims stand rejected under 35 USC 103(a) as allegedly being unpatentable over Miyabayashi EP 0875544 A1 in view of Ikeda et al or over this combination of reference further in view of Nagai et al or Miyabayashi EP 0900831 A2. Applicants respectfully traverse these rejections.

As discussed in the Background of the Invention in the present specification, there has been a need for a printing method which can yield images possessing excellent fixation, rubbing/scratch resistance and lightfastness, and good image quality on a **non-absorptive** recording medium, such as plastic, rubber, metal or ceramic. The claimed invention is based in part upon Applicants' finding that it is possible to achieve strong fixation of a colorant on the surface of a non-absorptive recording medium by contacting the recited reaction solution with the recited ink composition to form a coagulate on the surface of the recording medium and then washing with a polar solvent to wash away water or water-soluble organic solvent (see specification at page 3, lines 20-35; page 5, line 35 to page 6, line 6, and the Examples beginning on page 70). In line with this finding, claim 1 has now been amended with the

incorporation of the recitations formerly in claim 2, to recite that the recording medium is substantially non-absorptive.

The Examiner has acknowledged that the primary reference, Miyabayashi, does not teach either a recording medium that is non-absorptive to the recited ink composition or the step of washing the recording medium with polar solvent. The Examiner nevertheless maintains that Ikeda et al supplies these teachings and that it would have been obvious to combine Miyabayashi and Ikeda et al to arrive at the claimed invention. Applicants respectfully disagree.

In the recording process of Ikeda et al, the recording medium has small pores into which the ink composition is absorbed, as described in the reference in column 7, lines 58 to 65 and in Figure 1. Further, the reference states as follows in column 7, line 66 to column 8, line 4:

“Accordingly, the larger diameter the pore has, the higher the coloring ability and ink receptivity become. Also, the deeper the pore is, the higher the ink receptivity becomes. Hence, as conditions for electrolysis in the anodizing, it is preferable to select conditions under which pores can be formed in such a state.”

Figures 18 and 19 also show that the Ikeda et al ink composition is absorbed into the pores of the recording medium. In view of these disclosures, it appears that the recording medium used in the recording process of Ikeda et al is **absorptive** to an ink composition. Accordingly, it is respectfully submitted that Ikeda et al teach away from the claimed recording

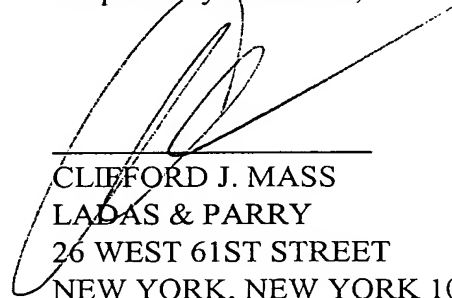
medium, which is substantially non-absorptive to the ink composition.

Moreover, the Ikeda reference describes a washing step for washing away the ink composition which is not absorbed into the pores of the recording medium. According to the description in Ikeda et al at column 12, lines 9 to 12, the dye of the ink composition is firstly absorbed into the pores of the recording medium and then the ingredients of the ink composition other than the dye are removed from the recording medium. The explanation in column 12, lines 47 to 49 of the reference shows that the unnecessary components other than dye as well as excess dyes that are not absorbed into the pores are rinsed with water. In the claimed recording process, the washing step is applied to the ink composition deposited on the recording medium, which substantially non-absorptive to the ink composition.

It may thus be appreciated that the object and function of the washing step in Ikeda et al differs from that of the claimed invention. In this connection, it is settled that, in order to make a *prima facie* case of alleged obviousness based upon a combination of references, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (see MPEP Section 2143.01). Where as here the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious (see MPEP Section 2143.01).

In view of the above, it is respectfully submitted that the prior art rejections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



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